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| WADDEY & PATTERSON, P.C. 1600 DIVISION STREET, SUITE 500 NASHVILLE, TN 37203 | | | WILLIAMS, JEFFERY L | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/628,282 | SHAPIRO, MICHAEL F. |
| | Examiner Jeffery Williams | Art Unit 2137 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 August 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1, 3, 4, 6 - 13, 15 - 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 3, 4, 6 - 13, 15 - 26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

This action is in response to the communication filed on 8/6/07.

All objections and rejections not set forth below have been withdrawn.

Claims 1, 3, 4, 6 – 13, 15 – 26 are pending.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show feature of the invention specified in the claims. Therefore, the added features of communication means including software for receiving...”, “wherein said device performs an initial verification of a user’s identity prior to transmitting any data to an external device”, “tamper resistant hardware or software that detects attempts to access data stored on the device or access a restricted portion of the device and erases stored data based upon said detection”, and “wherein an identity of the remote terminal is used to ensure that the remote terminal is a known or authorized source” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in response to the Office action to avoid abandonment of the application. Any amended or replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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1 is to be canceled, the appropriate figure must be removed from the replacement sheet,
2 and where necessary, the remaining figures must be renumbered and appropriate
3 changes made to the brief description of the several views of the drawings for
4 consistency. Additional replacement sheets may be necessary to show the renumbering
5 of the remaining figures. Each drawing sheet submitted after the filing date of an
6 application must be labeled in the top margin as either "Replacement Sheet" or "New
7 Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,
8 the applicant will be notified and informed of any required corrective action in the next
9 Office action. The objection to the drawings will not be held in abeyance.

10

11
12***Specification***

13

14 The specification is objected to as failing to provide proper antecedent basis for
15 the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction
16 of the following is required:

17 The specification fails to provide proper antecedent basis for the recitation "input
18 communication means including software for receiving..." as found within claim 1, line 5.

19 The specification fails to provide proper antecedent basis for the recitation
20 "wherein said device performs an initial verification of a user's identity prior to
21 transmitting any data to an external device" as found within claim 24.

22 The specification fails to provide proper antecedent basis for the recitation
23 "tamper resistant hardware or software that detects attempts to access data stored on

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1 the device or access a restricted portion of the device and erases stored data based
2 upon said detection" as found within claim 25.

3 The specification fails to provide proper antecedent basis for the recitation
4 "wherein an identity of the remote terminal is verified to ensure that the remote
5 terminal's is a known or authorized source" as found within claim 26.

6

7

8 ***Claim Rejections - 35 USC § 112***

9

10 The following is a quotation of the first paragraph of 35 U.S.C. 112:

11 The specification shall contain a written description of the invention, and of the manner and process of
12 making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
13 art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
14 set forth the best mode contemplated by the inventor of carrying out his invention.

15

16 Claims 1, 3, 4, 6 – 10, 24 – 26 are rejected under 35 U.S.C. 112, first

17 paragraph, as failing to comply with the written description requirement. The
18 claim(s) contains subject matter which was not described in the specification in such a
19 way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the
20 time the application was filed, had possession of the claimed invention. Applicant has
21 not pointed out where the new (or amended) claim is supported, nor does there appear
22 to be a written description of the claim limitations in the application as filed (see above
23 objection to the specification).

24

25

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

4 obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6 – 14, 15 – 19, 24 – 26 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Maes et al. (Maes), "Portable Information and

Transaction Processing System and Method Utilizing Biometric Authorization and

Digital Certificate Security", U.S. Patent 6,016,476 in view of Shore, U.S. Patent

Publication 2003/0149662 A1.

Regarding claim 1, Maes discloses:

a magnetic strip that is readable by a standard swipe card reader (Abstract; 4:12-28-55);

input communication means including software for receiving a request for an

authentication signal from a remote terminal (fig. 1:50,54,46,42,44, 48, 52, 56, 58, 12; 4:45-64):

Maes does not disclose that the portable computing device comprises a power
4.

However, it was well known to those of ordinary skill in the art to comprise power

supplies within portable computing devices (such as PDA's). For example, Shore

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1 discloses that a PDA authentication device comprises a power supply (fig. 1g:8a) so as
2 to function in a practical manner.

3 It would have been obvious to one of ordinary skill in the art to apply practical
4 prior art techniques, such as taught by Shore, within the PDA of Maes. This would have
5 been obvious because one of ordinary skill in the art would have been motivated by the
6 need for system functionality to provide a form of power.

7 *a biometric sensor for detecting biometric information and producing a sensed*
8 *biometric profile in a response to a received request for an authentication signal* (Maes,
9 fig. 1:18,40);

10 *a memory for storing a biometric profile corresponding to an individual* (Maes, fig.
11 1:14, 26);

12 *a processor for comparing the sensed biometric profile with the stored biometric*
13 *profile and producing an authentication signal* (Maes, fig. 1:12);

14 and output communication means for communicating the authentication signal to
15 the remote terminal (Maes, fig. 1:26, 50,54,46,42,44).

16

17 Regarding claim 3, the combination discloses:

18 *a proximity antenna for sending messages to, and receiving messages from,*
19 *another proximity antenna* (Maes, fig. 1:50,54,46,42,44).

20

21 Regarding claim 4, the combination discloses:

1 *a microphone for receiving audible signals and voice recognition software for*
2 *comparing said audible signals and with stored individual voice profiles* (Maes, fig.
3 1:18,16, 22; 4:45-64).

4

5 Regarding claim 6, the combination discloses:
6 *a speaker that allows the processor to produce voice responses* (Maes, 5:36-53).

7

8 Regarding claim 7, the combination discloses:
9 *magnetic strip writing means that allow the processor to alter information*
10 *contained on the magnetic strip* (Maes, fig. 1:30).

11

12 Regarding claim 8, the combination discloses:
13 *wherein said memory contains certification information that can be examined by*
14 *a remote terminal to determine if the device corresponds to an authorized account*
15 *(Maes, Abstract).*

16

17 Regarding claim 9, the combination discloses:
18 *wherein the biometric sensor further comprises a fingerprint detector and the*
19 *processor and memory further comprise fingerprint recognition software for determining*
20 *if a sensed fingerprint matches a stored biometric profile* (Maes, 5:55-67).

21

22 Regarding claim 10, the combination discloses:

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1 *wherein the portable device has a protrusion that is adapted to engage a swipe*
2 *card reader* (Maes, fig. 1:26).

3

4 Regarding claim 11, it is rejected, at least, for the same reasons as claim 1, and
5 furthermore because the combination discloses:

6 *a card swipe interface that allows stored data to be communicated to a magnetic*
7 *card reader* (Maes, fig. 1:26);

8 *a data input that allows said electronic data assistant to receive personal*
9 *identifying data from a remote source* (Maes, fig. 1:50,54,46,42,44);

10 *a memory for storing personal identification information related to a particular*
11 *individual* (Maes, fig. 1:14, 26);

12 *a processor for comparing said personal identifying data from said remote source*
13 *to said stored personal identification information and producing an authentication signal*
14 *based upon said comparison* (Maes, fig. 1:12);

15 *and a data output for communicating said authentication signal to a remote*
16 *source* (Maes, fig. 1:26, 50,54,46,42,44).

17

18 Regarding claims 12, 13, 15, 16, 17, 18, and 19, they are rejected, at least, for
19 the same reasons as the above rejected claims.

20

21 Regarding claim 24, the combination discloses:

1 *said device performs an initial verification of a user's identity prior to transmitting*
2 *any data to an external device (col. 10).*

3

4 **Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the**
5 **combination of Maes and Shore in view of Anderson, Security Engineering: A**
6 **Guide to Building Dependable Distributed Systems.**

7

8 Regarding claim 25, the combination of Maes and Shore does not appear to
9 explicitly recite the well established idea of *tamper resistant hardware or software that*
10 *detects attempts to access data stored on the device or access a restricted portion of*
11 *the device and erases stored data based upon said detection.*

12 Anderson discloses that for reasons of security, those of ordinary skill in the art
13 engineer devices as tamper resistant for the detection of tampering and erasing stored
14 data upon detection (Anderson, pg. 135, 216).

15 It would have been obvious to employ tamper resistance with the combination of
16 Maes and Shore because one of ordinary skill in the art would have been motivated by
17 the advantages of increased security.

18

19 **Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the**
20 **combination of Maes and Shore in view of Schneier, Applied Cryptography,**
21 **Second Edition.**

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1 Regarding claim 26, the combination of Maes and Shore does not appear to
2 explicitly recite *wherein an identity of the remote terminal is verified to ensure that the*
3 *remote terminal's is a known or authorized source.*

4 Schneier discloses that for reasons of security, communicating parties are
5 authenticated to each other (Schneier, pg. 2, 52-54).

6 It would have been obvious to employ authentication of the parties involved in
7 communication, as taught by Scheier, with the combination of Maes and Shore because
8 one of ordinary skill in the art would have been motivated by the advantages of security.

9
10 **Claims 20 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable**
11 **over Wang, “Portable Electronic Authorization Devices and Methods Therfor”,**
12 **U.S. Patent 5,917,913 in view of Maes et al. (Maes), “Portable Information and**
13 **Transaction Processing System and Method Utilizing Biometric Authorization and**
14 **Digital Certificate Security”, U.S. Patent 6,016,476.**

15
16 Regarding claim 20, Wang discloses:
17 *detecting a communication center's request for an identification with a portable*
18 *electronic device (4:8-30);*
19 *prompting an individual to respond to said request for an identification by*
20 *providing biometric information to said portable electronic device (11:5-13);*
21 *receiving said biometric information from said user (11:5-13);*

1 Wang states that the biometric information from the user is required to allow the
2 request for identification information to be satisfied. Wang, however, does not explicitly
3 state *processing* the received biometric information.

4 However, processing the biometric information entered by the user would have
5 been obvious to one of ordinary skill in the art. Maes shows that when a user enters
6 biometric information into a biometric authentication device, the device should process
7 such information in order for the device to make practical application of the entered
8 biometric information [i.e. verify the user](10:35-65).

9 It would have been obvious to one of ordinary skill in the art to employ the
10 processing of received biometric information as shown by Maes within the system of
11 Wang. This would have been obvious because one of ordinary skill in the art would
12 have been motivated by the need for security to verify users, and thus practically
13 perform steps necessary to do so.

14 *processing said biometric information to determine if said biometric information*
15 *corresponds to a biometric profile* (Wang, 11:5-13);

16 *producing an authentication signal ; and communicating said authentication*
17 *signal to said communication center in response to receiving said request for an*
18 *identification* (Wang, 11:24-31; 4:41-55).

19
20 Regarding claim 21, the combination discloses:
21 *wherein the step of receiving biometric information from said user further*
22 *comprises receiving a representation of said user's fingerprint* (Wang, claim 26).

Regarding claim 22, the combination discloses:

wherein the step of receiving biometric information from said user further

comprises receiving a voice sample from said user (Wang, claim 26).

Regarding claim 23, the combination discloses:

wherein the step of processing said biometric information to determine if said

biometric information corresponds to a biometric profile further comprises comparing the

biometric information to a biometric profile stored on a device carried by the individual

(Wang, 1:53-61; 5:51-6:13; fig. 3a; 302; 11:5-13; Maes 10:35-65).

Response to Arguments

Applicant's arguments filed 8/6/07 have been fully considered but they are not

persuasive.

Applicant argues or asserts primarily that:

(i) *Claims 1 recites a device having "a magnetic strip that is readable by a standard swipe card reader" and "a biometric sensor for detecting biometric information and*

1 *producing a sensed biometric profile in a response to a received request for an*
2 *authentication signal". Maes is different in that ... (Remarks, pg. 9)*

3

4 In response, the examiner respectfully notes that the applicant appears to be
5 mistaken. The prior art clearly discloses a device comprising a magnetic strip and
6 biometric sensor (Maes, claim 1, see also the rejection of claim 1).

7

8 (ii) *Claim 1 has been amended to recite "input communication means including*
9 *software for receiving a request for an authentication signal from a remote terminal".*
10 *The Office Action previously rejected this limitation based upon ... (Remarks, pg. 10)*

11

12 In response, the examiner respectfully notes that this limitation was not
13 previously rejected since it was never considered prior to the applicant's amendment.
14 For consideration of input means including software, the applicant may refer to the
15 rejection of claim 1 above.

16

17 (iii) Regarding claim 3, none of the output communication means disclosed in Maes
18 or Shore are proximity antennas. (Remarks, pg. 11)

19

20 In response, the examiner respectfully notes that the combination clearly
21 discloses communication means as proximity antennas. Furthermore, such
22 communication means allow the device to be used by simply placing the device in

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1 proximity to the reader while not outputting easily interceptable transmissions that are
2 detectable from a long distance.

3

4 (iv) *Claim 6 is ... this feature is totally lacking in any of the cited references*
5 (Remarks, pg. 11-13)

6

7 In response, the examiner respectfully notes that the applicant's collection of
8 arguments or assertions are unpersuasive for the same reasons as the first addressed
9 argument. Notably, the applicant appears to characterize device elements contrary to
10 the explicit teachings of the prior art of a device comprising, amongst other elements, a
11 cpu, memory, communication means, and a card (Maes, claim 1, Abstract).

12 Furthermore noted, the prior art clearly discloses a device that can manipulate a
13 magnetic strip on the device (Maes, fig. 1) and a blade shaped protrusion (fig. 1:26).

14

15 (v) *Thus, the identification data itself is not encrypted and sent to the remote*
16 *terminal as in Wang. Maes does not produce an authentication signal in response to a*
17 *request from a communication center.*

18 *Neither, Maes nor Shore discloses validating the biometric data with the device,*
19 *producing an authentication signal which is sent to the remote terminal and transmitting*
20 *the authentication signal to the remote terminal in a manner that prevents the remote*
21 *terminal from accessing the biometric data.* (Remarks, pg. 14, 15).

22

1 In response to applicant's argument that the references fail to show certain
2 features of applicant's invention, it is noted that the features upon which applicant relies
3 (i.e., *the identification data itself is not encrypted and sent to the remote terminal;*
4 *validating the biometric data with the device; transmitting the authentication signal to the*
5 *remote terminal in a manner that prevents the remote terminal from accessing the*
6 *biometric data; and produce an authentication signal in response to a request from a*
7 *communication center*) are not recited in the rejected claim(s). Although the claims are
8 interpreted in light of the specification, limitations from the specification are not read into
9 the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10 In response to applicant's arguments against the references individually, one
11 cannot show nonobviousness by attacking references individually where the rejections
12 are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208
13 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.
14 1986).

Conclusion

18 The prior art made of record and not relied upon is considered pertinent to
19 applicant's disclosure:

21 See Notice of References Cited.

1 Applicant's amendment necessitated the new ground(s) of rejection presented in
2 this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
3 § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
4 CFR 1.136(a).

5 A shortened statutory period for reply to this final action is set to expire THREE
6 MONTHS from the mailing date of this action. In the event a first reply is filed within
7 TWO MONTHS of the mailing date of this final action and the advisory action is not
8 mailed until after the end of the THREE-MONTH shortened statutory period, then the
9 shortened statutory period will expire on the date the advisory action is mailed, and any
10 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
11 the advisory action. In no event, however, will the statutory period for reply expire later
12 than SIX MONTHS from the date of this final action.

13 Any inquiry concerning this communication or earlier communications from the
14 examiner should be directed to Jeffery Williams whose telephone number is (571) 272-
15 7965. The examiner can normally be reached on 8:30-5:00.

16 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
17 supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone
18 number for the organization where this application or proceeding is assigned is 571-
19 273-8300.

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1 Information regarding the status of an application may be obtained from the
2 Patent Application Information Retrieval (PAIR) system. Status information for
3 published applications may be obtained from either Private PAIR or Public PAIR.
4 Status information for unpublished applications is available through Private PAIR only.
5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
6 you have questions on access to the Private PAIR system, contact the Electronic
7 Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a
8 USPTO Customer Service Representative or access to the automated information
9 system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10

11 J. Williams
12 AU: 2137

JW


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